

- - Remarks - -

Claims 1-29 remain in the case. Claim amendments have been made to point out more particularly Applicant's invention. It is respectfully submitted that the within amendment puts the case in better condition for allowance or appeal and as such Applicant requests that the within amendment be entered pursuant to the provisions of 37 CFR 1.116(b)(3).

Applicant respectfully submits that the application as amended meets and overcomes all objections and rejections, that all objections and rejections should be reconsidered and withdrawn, and that the amended application should be allowed as to all claims.

I. THE FINAL REJECTION WAS IMPROPER.

"A second or any subsequent action on the merits on any application . . . should not be made final if it includes a rejection, on prior art not on record, of any claim amended to include limitations which should reasonably have been expected to be claimed." MPEP, Sec. 706.07(a).

The foregoing squarely applies to render the final rejection in the pending Office Action improper.

Regarding Claim 1, it was clearly "reasonably expected" that Claim 1 would be amended in Applicant's prior amendment as it was that is, to make unmistakably clear that the screw recited therein is loosely disposed in a screw hole prior to fastening of clamping means by a nut; this, because the claim as originally presented recited "retention means engagable with said at least one screw for retaining said at least one screw in said at least one screw hole prior to fastening said clamping means," and the rejection in the prior

Office Action was on Cohen et al wherein there was no retention means for retaining a screw loosely held in the screw hole prior to fastening by a bolt .

Further, it should be noted that to the original 88-word claim only 44 words were added, clarifying the context as opposed to adding any “unexpected” limitation.

As regards all other claims besides currently Claim 1, the amendments were minor to say the least: Claim 7 (one word, eliminating informality; Claim 10 (one word, eliminating informality); Claim 13 (20 words added, one of which was to eliminate an informality, the remainder for adding clarity to description of context); Claim 14 (one word added, eliminating informality); Claim 21 (one word added, eliminating informality); Claim 22 (one word added eliminating informality); Claim 26 (14 words added, two to eliminate informalities and 12 to provide context for use of the invention).

Accordingly, Applicant respectfully submits that the finality of the rejection should be reconsidered and withdrawn. MPEP Sec. 706.07(a).

II. THE CLAIM OBJECTIONS IN THE OFFICE ACTION ARE NOT WELL-TAKEN OR HAVE BEEN ELIMINATED IN TERMS OF THE OBJECTED-TO INFORMALITIES.

Regarding currently amended Claim 1, Applicant respectfully submits that the objections are not well-taken and respectfully traverses same. In Claim 1 as currently amended, appears the following wording “said clamping means including at least one screw hole for receiving at least one screw for fastening, by securing at least one nut thereon, said clamping means over gasket means and said pipe ends, . . . ”. Claim 1, currently amended, lines 4-7. It is difficult to understand how the aforesaid passage could be

interpreted to mean by any tortured interpretation that the pipes are being claimed: clearly, what is claimed is the clamping means as part of the system "for facilitating coupling pipes at their ends in substantially fluid-tight relationship."

Also in Claim 1, Applicant does not understand the objection that "at least" should be inserted between 'said' and 'one'. This objection is incomprehensible because the words "at least" were already in the claim at the point referred to in the objection.

Also incomprehensible and erroneous is the objection concerning Claim 14, line 1, to the effect that "inserion" should be "insertion". The objection is invalid because the term "inserion" never appeared in Claim 14; rather, the word "insertion" was an informality that originally appeared in Claim 14, which was amended to eliminate that informality so that Claim 14 correctly reads "the invention as set forth in Claim 13 . . ."

Claim 13 (currently amended), line 12, has been amended to obviate the Examiner's objection.

Accordingly it, is respectfully submitted that all of the claim objections have been met and should be reconsidered and withdrawn.

III. REJECTION OF CLAIMS 1-29 UNDER 35 USC 103(a) AS ALLEGEDLY UNPATENTABLE OVER COHEN ET AL (US PAT. NO. 5,090,742) IN VIEW OF FISHER (US PAT. NO. 4,911,594) IS ERRONEOUS, IS TRAVERSED, AND SHOULD BE RECONSIDERED AND WITHDRAWN.

Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. *Para - Ordnance Manufacturing, Inc. v. SGS Importers, Inc.*, 73 F. 3d 1085, 37 USPQ 2d 1237 (Fed. Cir. 1985).

It is well-established that a reference should be considered as a whole and portions arguing against the claimed inventions must be considered. *Bausch & Lomb, Inc. v. Barnes - Hind/Hyrdocurve, Inc.*, 796 F.2d. 443, 230 USPQ 416 (Fed. Cir. 1995). As noted in *Gillette Company. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 16 USPQ 2d 1923 (Fed. Cir. 1990), the closest prior art reference "would likely discourage the art worker from attempting the substations suggested by [the inventor/patentee]."

The rejection under 35 USC Sec. 103(a) of Claims 1-29 as allegedly unpatentable over Cohen et al in view of Fisher is at variance with and erroneous under the foregoing controlling authorities. As stated in the appended declaration of inventor John Curran, who has 12 years of experience in the art to which the present invention pertains, the Fisher device operates in a totally different manner from his invention and is not particular popular or well-liked in the industry. Curran Declaration para. (3).

The Fisher device is placed over the end of a screw and in contact with a coupler at the screw hole and as such it can bind during the process of placing and moving along the screw if the Fisher device is in any manner placed or moved off-center. If for any reason, it is desired to remove the screw- - with the Fisher device on it - - prior to permanent fastening of the screw, the Fisher device must be cut off the screw. Also, the Fisher device being made of metal presents the potential for corrosion and in addition the Fisher

device is less flexible in terms of sizing than Applicant's invention in that the Fisher device must fit snugly over the screw. *Ibid.*

All of the foregoing is in stark contrast to Applicant's invention. No prongs are employed with Applicant's invention, nor is Applicant's invention required to be placed over the end of a screw; rather, it is positionable laterally on the screw at the contact point with the clamp and retains the screw in the screw hole by resiliently engaging the screw so that it cannot fall out of the screw hole. If it is desired to remove the screw before the screw is permanently fastened, the Applicant's retention means can simply be removed by manual manipulation. The Applicant's retention means is made of thin flexible material which need not be metal, thus presenting no corrosion risk. In addition, there is substantial flexibility with respect to size because Applicant's retention means does not need to be sized precisely to the dimensions of the screw in view of its resiliency and the manner in which it is fitted on to the screw to retain it on the screw hole prior to permanent securing/fastening thereof.

The use of Cohen et al as a basic reference is clear error. The Cohen et al device employs "washers, such as disk washers, . . . on the clamping bolts for maintaining preload." Cohen et al, col. 1, lines 45-47, 57-64.

The problem solved by the Cohen et al device is stated as follows: "harness clamps for use when pipes are axially coupled are known in the art, but known clamps are not satisfactory in maintaining preload. The clamps halves and bolts may relax and initial preload is lost, resulting in leakage of fluids carried by the pipes." Cohen et al, col. 1, lines 9-14.

It appears from the Office Action that the rejection on Cohen et al is predicated upon the contention that the Belleville washers 18 in Cohen et al correspond to the retention means recited in the claims herein. This, however, is wholly incorrect and at variance with the clear teaching and claim language of the instant patent application as well as Cohen et al.

As stated in Cohen et al: "In a non-limiting example of a pipe harness clamp of the invention, the clamp may be fabricated of carbon steel of $\frac{3}{4}$ inch thickness and 10 inches wide. The Belleville washers may be of steel having spring rates suitable for the required preload. Belleville washers may be obtained from Associated Spring. The bolts are preloaded by torque wrench using a torquing sequence to assure that *all bolts are uniformly loaded and the Belleville washers compressed.*" (Emphasis added). Cohen et al, col. 3, lines 45-54.

In stark contrast it is recited in currently amended Claim 1: "retention means engageable with said at least one screw for retaining said one screw in said at least one screw hole prior to fastening said clamping means together by securing said at least one nut with said at least one screw, said retention means being positionable from the side of the shank of said at least one screw into engagement with said at least one screw to retain said at least one screw, prior to fastening said clamping means together by securing said at least one nut to said at least one screw."

See also currently amended Claim 1 which recites, "Clamping means for clamping around said pipe ends said clamping means including at least one screw hole for receiving at

least one screw for fastening, by securing at least one nut thereon, said clamping means over gasket means and said pipe ends, said at least one screw being configured such that it is loosely disposed in said at least one screw hole prior to fastening of said clamping means; . . . ”

Clearly and unmistakably the structure and function of the “Belleville washers” and of the “retention means” of the present application are totally separate and distinct. In the Cohen et al structure, the Belleville washers provide capability for maintaining preload force in a bolted arrangement whereas in the instant application, the retention means are exactly what they are stated to be “retention means” to prevent screws from falling out of screw holes prior to clamping accomplished by a bolt mounted on the screw to fasten the clamps together as well as holding the screw in place. There is no aspect of distributing or maintaining preload on the part of the retention means in the instant application whereas, the Belleville washers of Cohen et al have no purpose to prevent a screw upon which they are mounted from slipping out of a screw hole.

The structure and function of the retention means herein are wholly different from the structure and function of washers which according to common parlance, the Cohen et al patent and dictionary definition are “any of various flat thin rings or perforated plates (as of metal or leather) used in joints or assemblies to insure tightness, prevent leakage, or relieve friction.” See Webster’s Third New International Dictionary page 2579 (1981), per Exhibit 1 attached hereto and incorporated by reference herein.

Accordingly, it is error to cite the Cohen et al device as a basic reference in view of the important structural and functional differences between the retention means of the present application and the Cohen et al Belleville washers.

Also erroneous is the attempted combination of Cohen et al and the Fisher reference. As stated in the declaration of John M. Curran: "the attempt to combine the Fisher and the Cohen et al references makes no sense at all from a practical point of view. If the Cohen et al device is in place that means that the bolts and screws are already fastened in the coupler and the only problem/issue is how to maintain a preload. Under those circumstances, there can be no reason to attempt to hold the screws in their screw holes to retain the screws in the screw holes when they are located therein since they are already fastened within the screw holes. I do not know of any construction project where after the Cohen et al device was applied there would then be a retention means to hold the screws in the screw holes. This would be nonsensical." Curran declaration, para. (4).

Clearly, there would be no incentive for anyone skilled in the art to seek to combine the two references nor is there any showing or suggestion of the desirability or feasibility of combining the Fisher and Cohen et al references, thus rendering the attempted combination invalid. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 443 (Fed. Cir. 1992). Further, the structure and function of the Fisher device are totally distinguishable from those of the retention means herein. As stated in the declaration of inventor John M. Curran, who has seen the device in the Fisher reference in his years of experience in the field, "It [the Fisher device] is difficult to work with, operates in a totally different manner from my invention, and is not particularly popular or well-liked. The device in the Fisher reference which has a metal plate with a hole in the middle together with a plurality of

fingers – prongs extending from the plate, can be used only by placing over the end of a screw. When the Fisher device (which is referred to as a push nut fastener), is placed over the end of a screw and in contact with a coupler at the screw hole, it can bind during the process of placing and moving along the screw if the device is in any manner placed or moved off-center. Also, if for any reason it is desired to remove the screw before it is permanently fastened, the Fisher device must be cut off the screw, with a potential for damaging the screw or, alternatively, the screw itself must be cut, with obvious problems. In addition, because the Fisher device is made of metal, there is risk of corrosion and further, the Fisher device is less flexible in terms of sizing in that the Fisher device must fit snugly over the screw.” Curran declaration, para. (3).

The distinction between the retention means of the present application and the Fisher device is clearly stated in the Curran declaration: “In contrast to the Fisher device, my invention is not applied over the end and along the length of a screw that is to be retained; rather, it is simply mounted sideways on the screw that is, it is just simply fitted over the screw from the side of the screw. Further, if there is any reason to remove the screw before it is finally fastened, all that is necessary is that my retention ring simply be removed by hand. Moreover, my retention ring is made of thin flexible material which not need be metal and thus presents no corrosion risk. Also, there is complete flexibility with respect to size because my device does not need to be sized precisely to the dimensions of the screw in view of its resiliency and the manner in which it is fitted onto the screw to retain it in the screw hole prior to permanent securing/fastening..” Curran declaration, para. (5).

Regarding currently amended Claims 8 and 20, the contention in the Office Action that “Fisher’s washer includes a lateral slot (e.g. between fingers 16 and 18 in Fig. 1), is incorrect and irrelevant in any event. In the first place, there is no reference numeral designating any “slot”, nor is there any reference in the text of Fisher including claims and specification to any “slot.”

In any event, even if there were a “slot” (which is patently not the case) it would not correspond to the “opening” recited in currently amended claims 8 and 20. As noted above, the function of the “opening” in the claimed invention herein is to enable lateral positioning of the retention means onto the shank of the screw. Since it is inarguable that such positioning cannot take place in Fisher and that all positioning upon the screw occurs on the end thereof, there is no pertinence to any real or imagined “slot” in Fisher concerning patentability of claims in the instant application.

Concerning claims 12 and 24, the Office Action alleges that “as Applicant did not properly challenge the Examiner’s taking official notice of the use of adhesion means to adhere a washer to a screw or bolt, such is considered admitted prior art.” Office Action, page 3, lines 15-17. This, however, is wholly erroneous and lacking in any factual foundation whatsoever. Contrary to the Examiner’s contention, Applicant took vigorous exception to the “official notice” attempted to be taken by the Examiner in the prior Office Action. As stated in Applicant’s amendment in response to Office Action dated 08/11/05: “regarding Claims 12 and 24, the Office Action contends: ‘Cohen et al fail to teach adhesion means for adhesion to the screws. The Examiner takes official notice of the use of adhesion means to adhere a washer to a screw or bolt.’ . . .

"To the contrary, the washers in Cohen et al would experience no benefit with respect to their structure and function by having 'adhesion means' associated therewith, since the Cohen et al washers will be thrust against other washers and finally against clamping means and/or a fastening nut by frictional engagement due to the nut's being screwed on to the screw member in connection with fastening the clamps to one another. It would be absolutely pointless and contraindicated to add adhesion members to the already tightly-engaged clamp/screw/nut/washer assembly. In contrast, adhesion means are wholly appropriate for the retention means of the instant application as specifically stated in the claims under discussion, claims 12 and 24, the adhesion means having the purpose and function of retaining the screws in the screw holes prior to fastening the screws between the clamps by means of a nut screwed on to the screw/bolt. Thus, any 'official notice' of the use of such adhesion means is wholly erroneous as being at variance with the overall tenor of the art, of common practice and of the Cohen et al reference as well as the instant application." Applicant's Amendment in Response to Office Action dated 08/11/05, page 19, lines 1-14.

Accordingly the "official notice" relied upon in the Office Action is erroneous in itself. Moreover, as noted in the prior response quoted above, there can be no possible utility or advantage in applying "adhesion means" to the Belleville washers in Cohen et al, nor can there be any possible rationale for employing adhesion means in the Fisher device which, as noted in the Curran declaration, is so tightly affixed to the screw that it must be cut off the screw if for some reason the screw is to be removed prior to being bolted to the clamps. Curran declaration, para. 3.

Accordingly, all independent claims remaining in the case are patentable as are all dependent claims; in addition, the specifically singled-out claims referred to in the Office Action and discussed hereinabove, have been shown to be clearly patentable in and of themselves.

Therefore, all claim rejections on the grounds of obviousness under 35 USC 103(a) must be reconsidered and withdrawn, and all claims in the application should be allowed.

IV. CONCLUSION.

Based upon the foregoing, Applicant respectfully submits that all objections and rejections have been addressed and resolved, that all objections and rejections of the claims as amended should be withdrawn, and that all claims should be allowed. Therefore, it is respectfully submitted that the within amendment should be entered as placing the application in better condition for allowance or appeal. 37 CFR Sec. 1.116(b)(3).

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